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10/067,729	02/07/2002	Brian Patrick O'Hara		7195

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EXAMINER

ARYANPOUR, MITRA

ART UNIT PAPER NUMBER

3711

DATE MAILED: 05/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/067,729	O'HARA, BRIAN PATRICK	
	Examiner	Art Unit	
	Mitra Aryanpour	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-25 is/are pending in the application.
- 4a) Of the above claim(s) 21-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Election/Restrictions***

1. Newly submitted claim 21-25 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The original claims 1-5 were directed to a product. The newly submitted claims 6-20 (Invention I) are directed to a product. While claims 21-25 (Invention II) are directed to a process. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product such as in golf swing training. Since applicant has received an action on the merits for the originally presented invention (claims directed to a product), this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 21-25 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Specification

2. The disclosure is objected to because of the following informalities: in paragraph 0016, line 9 of the amended specification "securely" should be changed to --secured--. Appropriate correction is required.

Claim Objections

3. Claims 6-15, 18, 19, 23, 24 are objected to because of the following informalities: in claim 6, line 4, "an L-shaped" should be changed to --a L-shaped--; in line 5, ":" should be

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changed to either --;-- or --,--; in claim 18, line 3, "an L-shaped" should be changed to --a L-shaped--; in claim 23, line 2, "an L-shaped" should be changed to --a L-shaped--. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 6-9, 11-19 are rejected under 35 U.S.C. 102(a) as being anticipated by Halfacre (6,582,318).

Regarding claim 6, Halfacre discloses an apparatus for training device comprising: a belt (210) for attachment to a user at the user's hip; and a L-shaped member (266) comprising a backing piece (265b) and a protruding arm (combination of 220 and 280), said protruding arm (combination of 220 and 280) including a rectangular cut out (slot 272) to receive said belt (210); wherein said backing piece (265b) is between said belt (210) and the user when the belt is attached to the user (see figure 7B). Note: The preamble, an apparatus for teaching fast-pitch softball pitching, does not limit the structure of the claimed device because the portion of the claim following the preamble is a self-contained description of the structure and does not depend on the preamble for completeness. Additionally, it should be noted a recitation of the intended use of the claimed invention in the instant case a belt for attachment to a user's hip must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of

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performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Regarding claim 7, Halfacre shows an approximately rectangular block of padding (the broadest reasonable interpretation of rectangular block would include the area between top side 282, bottom side 282 and back 288 and front side 286) attached to said L-shaped member (the cover encasing 280) within the angle spanned by the backing and the protruding arm.

Regarding claims 8 and 9, Halfacre shows said padding comprising foam padding and a cover surrounding said padding and said L-shaped member (see column 8, lines 1-3).

Regarding claim 11, Halfacre shows a pad attached to said backing, wherein said pad is between the backing and the user when the apparatus is attached to the user (see column 5, lines 59-64).

Regarding claim 12, Halfacre shows the protruding arm protrudes about 16 cm (the broadest reasonable interpretation of about 16 cm would include 19 cm (7.5 inches)) from the user when the apparatus is attached to the user. It should be noted that Halfacre teaches that the size and angle can vary depending on the size of the end user (see column 7, lines 58-67).

Regarding claims 13 and 14, Halfacre shows said belt (210) comprising an attachment means which is a hook and loop material.

Regarding claim 15, Halfacre shows said apparatus adopted for use by right-handed and left-handed users (see column 1, lines 65-67 and column 2, lines 1-3).

Regarding claim 16, Halfacre discloses a training apparatus comprising: a padded rectangular parallelepiped member (280, the six faces include 288, 284, 282, 286 287 and 289)

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attached to a belt (210), said belt (210) adapted to be worn around the hip of a user, and said parallelepiped member (280) positioned to extend laterally from said belt when worn by a user and having a dimension such that the user's arm contacts the parallelepiped member at about the user's forearm when the apparatus is worn by a user and the user's arm is fully extended (see figures 8A through 11).

Regarding claim 17, note the rejection of claim 12.

Regarding claim 18, note the rejection of claims 6 and 7.

Regarding claim 19, note the rejection of claim 11.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Halfacre (6,582,318).

Regarding claim 10, Halfacre does not disclose expressly the use of leather for the cover. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to use a leather covering for the padding, because Applicant has not disclosed that using a leather covering for the padding, provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either the covering taught by Halfacre or the claimed leather covering because both coverings perform the same

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function of enclosing the foam padding. Therefore, it would have been an obvious matter of design choice to modify Halfacre to obtain the invention as specified in claim 10.

Regarding claim 20, note the rejection of claim 10.

Response to Arguments

8. Applicant's arguments with respect to claims 6-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Halfacre ('421); Todaro; Jump, Jr; Harrison (WO); Cooley.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mitra Aryanpour whose telephone number is 703-308-3550. The examiner can normally be reached on Monday - Friday 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MA
26 May 2004


MITRA ARYANPOUR
PATENT EXAMINER